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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,390	11/20/2003	Ronald F. Palermo	10670013010202	9732
37211 7590 09/17/2008 BASCH & NICKERSON LLP 1777 PENFIELD ROAD PENFIELD, NY 14526				
EXAMINER				
WOLFSCHLAGER, JEFFREY MICHAEL				
ART UNIT		PAPER NUMBER		
1791				
NOTIFICATION DATE		DELIVERY MODE		
09/17/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/718,390

Applicant(s)

PALERMO ET AL.

Examiner

JEFFREY WOLLSCHLAGER

Art Unit

1791

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-10, 12, 13 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 3-10 and 13 is/are allowed.
- 6) ☒ Claim(s) 20-23 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 18, 2008 has been entered.

Response to Amendment

Applicant's amendment to the claims filed July 18, 2008 has been entered. Claims 1 and 20 are currently amended. Claims 20-23 are new. Claims 2, 11, and 14-19 have been canceled. Claims 1, 3-10, 12, 13 and 20-23 are pending and under examination.

Claim Objections

Claim 12 is objected to because of the following informalities: Claim 12 recites that it depends from claim 11. However, claim 11 has been canceled. Appropriate correction is required (e.g. amend claim 12 so that it depends from claim 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaw et al. (US 6,033,146) in view of Harvey (US 6,568,146) and Danielsson (US 4,281,496).

Regarding claims 20 and 22, Shaw et al. teach a method for forming a decorative concrete material containing integrated aggregate with the following steps: preparing and forming the region upon which the monolithic concrete floor is to be poured (col. 3, lines 31-33); contiguously pouring concrete throughout the formed region (col. 3 lines 42-45); striking off/screeding and floating the concrete to effectively densify the concrete (col. 3, lines 53-55 and 57-60); and implicitly allowing the concrete to become semi-stiff because the concrete is intrinsically semi-stiff as evidenced by col. 4, lines 14-16 and due to the fact that time has passed since the completion of the floating step. Next, to the finished, generally planar surface, a quantity of decorative aggregate, having a particle size of less than 3/8"9 mm (col. 4, lines 5-8), is disbursed over the semi-stiff concrete surface (col. 3, line 65 – col. 4, line 5) and is then integrated into the upper surface of the concrete (col. 4, line 17-19). The concrete with the integrated aggregate is then partially cured (col. 4, lines 27-30), and the surface is washed and brushed such that no more than five percent of the particulates are removed (col. 4, lines 36-50). The concrete is then fully cured and washed and undergoes additional grinding and is

polished (col. 4, lines 55-65) to provide a generally planar and smooth/flat (Abstract; col. 5, lines 25-26) monolithic concrete floor.

Although Shaw et al. teach that grinding may be performed on the fully cured floor, they do not teach grinding the partially cured concrete containing integrated aggregate using a series of successively finer abrasives with a rotary head grinding machine. However, Danielsson teaches an analogous method for forming a concrete floor where a rotary grinder (col. 1, lines 56-64; col. 7, line 64-col. 8, line 19) is used to grind the floor after it is hardened/partially cured, but prior to the floor being fully cured to produce a floor having a flat surface (Abstract; col. 2, lines 17-22; col. 3, lines 30-35 and 46-58; col. 6, lines 47-52) and Harvey teaches an analogous method of manufacturing a decorative cementitious floor wherein the floor containing decorative aggregates is partially cured and then ground to a smooth, fine, finish by progressively grinding the surface using sanding wheels/rotary heads (Abstract; col. 3, lines 36-67).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have modified the method of Shaw et al. and to have ground the partially cured concrete floor containing decorative aggregates, thereby partially removing some of the concrete and the aggregate, as suggested by Danielsson and Harvey, since Harvey suggests grinding concrete floors in this condition facilitates the production of a fine, smooth surface suitable for a decorative concrete floor application containing aggregates and Danielsson teaches grinding concrete while it is still not fully cured improves the efficiency of the grinding step (col. 8, lines 11-19).

With regards to claim 20, the "consisting essentially of" language in the claims is noted. The transitional phrase "consists essentially of" limits the scope of the claim to the specified materials or steps "and those that do not materially affect the basic and novel characteristics" of the claimed invention. In re Herz, 537 F.2d 549, 551-52, 190 USPQ 461, 463 (CCPA 1976). For

search and examination purposed, absent a clear indication in the specification of what the basic and novel characteristics actually are, "consists essentially of" will be construed as equivalent to "comprising." When an applicant contends that additional steps or materials in the prior art are excluded by the recitation "consists essentially of," applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of applicant's invention. In re De Lajarte, 337 F.2d 870, 143 USPQ 256 (CCPA 1964). See also Ex parte Hoffman, 12 USPQ2d 1061, 1063-64 (Bd. Pat. App. & Inter. 1989). Because no evidence has been set forth on the record to show that the use of the additional steps and materials set forth by Shaw et al (e.g. screeding, washing, surface retarder) would materially affect the basic and novel characteristics of the instantly claimed invention, its use is considered to fall within the scope of the instant claim.

As to claims 21 and 23, Danielsson teaches that the floor is cured for a period of approximately 1-7 days prior to grinding (col. 2, lines 14-22; col. 7, line 64-col. 8, line 19).

Therefore it would have been *prima facie* obvious to one having ordinary skill in the art at the time of the claimed invention to have modified the method of Shaw et al. and to have partially cured the concrete for a period within the claimed timeframe prior to grinding, as suggested by Danielsson, since Danielsson suggests this is a suitable curing time to allow for effective grinding of a partially cured concrete floor.

Allowable Subject Matter

Claims 1, 3-10 and 13 are allowed.

The following is an examiner's statement of reasons for allowance: the prior art of record does not teach or suggest a method for forming an integrated ornamental surface on a monolithic concrete floor concurrent with the pouring and finishing of the concrete floor

comprising grinding the upper surface of the partially cured concrete including partially removing some of both the partially cured concrete and the integrated aggregate until the aggregate is exposed uniformly over the top of the concrete including completing the grinding step in a way that comprises a rough first pass using a rotary head grinding machine having a cutting head of diamonds; a second pass using a finer grit on a disc comprised of silicon carbide and a bonding material; and a polishing pass with a rotary head polishing machine using between about a 200 grit to a 1600 grit diamond pad and further including the aggregate has a particulate size of at least 6 mm and no more than 50 mm in combination with the other features instantly claimed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

Applicant's arguments filed July 18, 2008 and May 15, 2008 (Pre-appeal Brief Conference Request) directed to the 35 USC 112 first paragraph rejection have been fully considered. First, the arguments directed to "non-cementitious decorative aggregate", in claims 1 and 20, are moot in view of the amendment which removes this limitation from the claims. Second, applicant's arguments directed to the rejection of claim 20, and the use of the transitional phrase "consisting of", are moot in view of the amendment to the claim. Finally, applicant's arguments directed to the limitation "about", referring to the grit of the diamond pad, in previous claim 11, have been considered and they are persuasive. Accordingly, the limitation "about", now found in amended claim 1, is not rejected under 35 USC 112 first paragraph.

Applicant's arguments filed July 18, 2008 and the remaining applicable arguments from the Pre-appeal Brief Conference Request filed May 15, 2008 have been fully considered regarding new claims 20-23, but they are not persuasive. Applicant argues that Shaw et al. do not form a generally planar and smooth surface by removing both concrete and aggregate. Specifically, applicant argues that Shaw et al. expose the aggregate through non-grinding steps. This argument is not persuasive. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The examiner notes that Shaw et al. do intend to form an exposed aggregate concrete (col. 1, line 7-10) and that it is desired by Shaw et al. that this exposed aggregate concrete is extremely flat (Abstract; col. 5, lines 25-26) in order to provide a terrazzo like (col. 3, lines 6-9) appearance (which is also the intention set forth in the instant application). Applicant argues that Danielsson does not teach grinding to achieve a uniformly exposed aggregate. This argument is not persuasive. The examiner submits this is not the reason Danielsson is combined with Shaw et al. Danielsson is combined for the teaching that grinding a partially cured concrete improves efficiency as opposed to grinding a fully cured concrete. Applicant argues that Harvey teaches pouring concrete in place over an existing subfloor and as such teaches away from the claimed invention. This argument is not persuasive. The examiner submits that Harvey is a secondary reference in the rejection and is applied for teaching that a smooth, fine, finish can be achieved on a concrete floor containing aggregates by progressively grinding the surface. Finally, applicant argues that the grinding of Harvey would result in additional steps and cost when compared to Shaw, further indicating nonobviousness. This argument is not persuasive. The examiner submits that the combination teaches that grinding a partially cured concrete floor

containing aggregates through a progressive grinding method is an effective way of achieving a fine, smooth surface. Since Shaw et al. desire such a surface, the examiner submits one having ordinary skill would have been motivated to employ such a grinding technique in view of the combined teachings of the references.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JEFFREY WOLLSCHLAGER whose telephone number is (571)272-8937. The examiner can normally be reached on Monday - Thursday 6:45 - 4:15, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Johnson can be reached on 571-272-1176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeff Wollschlager/
Examiner, Art Unit 1791

September 15, 2008